

promotional award amounts given to the associated customer, and the "award time" storage 131 stores a time of or time since a last promotional award was given to the associated customer. As such, one skilled in the art would recognize that the claimed "visitor parameter storage" corresponds to the storage areas 124, 129 and 131 as disclosed in the application as originally filed. Alternately expressed, it would be recognized by one skilled in the art that the storage areas 124, 129 and 131 as originally disclosed and described in the specification correspond to visitor parameter storages that contain information pertaining to prior visits to a site by visitors identified in the customer identifier storage.

Applicant agrees with the Examiner that the term "visitor parameter storage" was not described *per se* as stated in the Office action. However, the test for determining sufficiency of the written description is not whether the claimed subject matter is described identically in the original specification, but only whether the disclosure reasonably conveys to persons skilled in the art that the inventor had possession of the subject matter in question. Fujikawa v. Wattanasin, 93 F.3d 1559, 39 USPQ2d 1895 (Fed. Cir. 1996); In re Wilder, 736 F.3d 1516, 222 USPQ 369 (Fed. Cir. 1984). In other words, the written description requirement is not an *ipsis verbis* test. Thus, the mere fact that the term "visitor parameter storage" was not mentioned *per se* in the specification as originally filed does not support a conclusion that the invention of claim 1 is not supported by an adequate written description. In view of the above, reconsideration and withdrawal of the 35 U.S.C. § 112 first paragraph rejection is requested.

### **35 U.S.C. § 103 Rejection**

The rejection of claims 1-13, 15-21 and 23-25 under 35 U.S.C. § 103 as being unpatentable over Leason et al. ("Leason") in view of newly cited U.S. Patent No. 5,862,325 to Reed et al. ("Reed") is respectfully traversed.

As previously explained, Leason does not disclose a method or apparatus for providing promotional awards to a visitor of an electronic commerce site by keeping track of the identity of visitors to the site, storing visitor parameter information pertaining to prior visits of identified visitors to the site, and crediting promotional

awards by applying defined awards rules to the visitor parameter information stored for each visitor to the electronic commerce site.

In Leason, no identification of the visitor is performed. See col. 2, ll. 18-19. Consequently, no information pertaining to prior visits of the visitor to the web site is or can be stored in Leason. To the contrary, Leason simply allows an anonymous visitor to validate reward codes, and then redeem the codes in the form of access to a restricted web page or activation of a coded coupon, in real time.

Reed fails to cure this fundamental deficiency in Leason with respect to the claimed invention. Reed is directed to an automated data communication system which coordinates the transfer of data, metadata, and instructions between databases in order to control and process communications. Reed is completely irrelevant to the Leason system and irrelevant to the claimed invention. Leason is directed to a method for encouraging individuals to visit designated web sites by awarding the individuals "e-points," wherein rewards in the form of game cards or receipts are distributed to individuals at point of sale locations such as retail stores, movie theaters, etc. The rewards contain codes and designate Internet web sites at which the individual may validate the codes to obtain the "e-points." E-points may be accumulated by individuals during a single on-line session by entering additional codes from additional game cards or receipts.

The Office action has failed to establish a *prima facie* case of obviousness with respect to the pending claims. In order for a claim to be obvious under 35 U.S.C. § 103, there must be some teaching, suggestion or motivation in the prior art to have arrived at the claimed invention. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

The Office action provides no such motivation, teaching or suggestion in proposing to combine "the disclosures of Reed with the teachings of Leason." That such combination "would have provided means" as claimed in the present application does not constitute such a teaching, suggestion or motivation. In other words, the "motivation to combine" under § 103 is not motivation to arrive at the claimed invention as alleged in the Office action, but instead must be motivation as described in the prior

art to overcome some stated problem, achieve some stated purpose, or make some stated improvement.

The Office action has failed to explain where the Reed reference provides any suggestion or motivation to one of ordinary skill in the art to have provided a visitor identification storage and associated visitor parameter storage in an electronic commerce apparatus as claimed. Reed is concerned with establishing an automated communications relationship between providers and consumers of information. Reed is not concerned with any game, lottery or any other type of promotional system as is the subject matter of Leason.

The Office action has further failed to show precisely where Reed discloses any of the features of the claimed invention admittedly missing from Leason. Specifically, the Office action has not pointed out where in "col. 6, ll. 48-67; col. 7, ll. 1-10, col. 78, ll. 25-67; col. 82, ll. 36; the ABSTRACT; FIG. 1; FIG. 3; FIG. 11; FIG. 15; FIG. 20; FIG. 34A; AND FIG. 35" Reed is alleged to disclose the relatively simple elements of providing a unique customer identification storage for each visitor to a site, and visitor parameter storage that contains information pertaining to prior visits to the site by visitors identified in the customer identification storage. If Reed in fact disclosed such a feature, it is not understood why reference must be made to four columns of disclosure and seven drawing figures to explain where such feature is disclosed.

Applicant has reviewed the prolix recitations to the Reed disclosure, and is unable to discern any disclosure of any of the features of the claimed invention that admittedly are not disclosed in Leason. Consequently, in addition to the above stated reason, it is respectfully submitted that no combination of Reed with Leason would result in the invention as set forth in the claims pending in this application. Reconsideration and withdrawal of this ground of rejection is thus requested.

In the event that the Examiner persists in this rejection, the Examiner is requested to concisely explain with pinpoint citations precisely where the Reed reference discloses the alleged features proposed to be combined with Leason.

In view of the foregoing, favorable reconsideration of this application, withdrawal of the outstanding grounds of rejection, and the issuance of a Notice of Allowance are earnestly solicited.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2135.

RESPECTFULLY SUBMITTED,					
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